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Filing date: **04/30/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91214779
Party	Defendant Marke Enterprises, LLC
Correspondence Address	SONIA F LAKHANY LILENFELD PC 2970 PEACHTREE RD NW , SUITE 530 ATLANTA, GA 30305 2114 UNITED STATES sonia@lilenfeldpc.com, david@lilenfeldpc.com
Submission	Other Motions/Papers
Filer's Name	Brian J. Jacobs
Filer's e-mail	brianjacobs21@yahoo.com
Signature	/Brian J. Jacobs/
Date	04/30/2014
Attachments	Brief in Opposition to Order to Show Cause.pdf(285645 bytes ) Exhibit A.pdf(92229 bytes ) Exhibit B.pdf(39647 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN THE MATTER OF APPLICATION SERIAL NO. 86038104

PUBLISHED IN THE OFFICIAL GAZETTE OF JANUARY 7, 2014

COMBE INCORPORATED,	)	
	)	
Opposer,	)	Opposition Proceeding
	)	No. 91214779
v.	)	
	)	
MARKE ENTERPRISES, LLC,	)	
	)	
Applicant.	)	

**BRIEF IN OPPOSITION TO ORDER TO SHOW CAUSE  
WHY JUDGMENT BY DEFAULT SHOULD NOT BE  
ENTERED AGAINST APPLICANT IN ACCORDANCE  
WITH FED.R.CIV.P. 55(b) (2)**

Applicant Marke Enterprises, LLC, a Georgia limited liability company ("Applicant"), hereby files its response to the notice of default mailed on April 1, 2014 in the above-captioned proceeding.

**I. INTRODUCTION AND STATEMENT OF FACTS**

On August 14, 2013, Applicant filed its Application, Serial No. 86038104 (the "Application"), seeking registration of the trademark VAGISERT ("Applicant's Mark"), and on February 5, 2014, Combe Incorporated, a Delaware corporation ("Opposer"), filed its Notice of Opposition to the Application (the "Opposition"), claiming that Applicant's Mark is confusingly similar to Opposer's trademark VAGISIL, for which Opposer has

eight outstanding registrations. Pursuant to the scheduling order of February 5, 2014, a response to the Notice of Opposition was due on March 17, 2014. However, while Applicant was represented by the firm Lilenfeld PC ("Lilenfeld") in the preparation of the Application, such firm declined to represent Applicant in the Opposition proceeding. Declaration of Markela Taylor ("Decl."), ¶¶7-8 & Exh. "B." As a result, Applicant was unable to submit an Answer to the Opposition within the mandated time period, and a notice of default was mailed on April 1, 2014 (the "Notice of Default"), providing Applicant thirty days within which to show cause why default judgment should not be entered against Applicant pursuant to Fed.R.Civ.R. 55(b)(2). This response follows.

**II. DEFAULT JUDGMENT SHOULD NOT BE ENTERED AGAINST APPLICANT BECAUSE APPLICANT SATISFIES THE THREE FACTORS JUSTIFYING OPENING ITS DEFAULT**

The Federal Rules of Civil Procedure provide the basis for determining whether a default in an inter partes proceeding should be set aside. See, Paolo's Associates Ltd. Partnership v. Brodo, 21 U.S.P.Q.2d 1899, 1902, 1990 WL 358312 (Comm'r Pat. & Trademarks 1990) ("Brodo"). In particular, the non-defaulting party is not entitled to a default judgment as a matter of right. Genther v. Ingle, 75 F.3d 207, 209 (5th Cir. 1996); Wahl v. McIver, 773 F.2d 1169, 1174 (11th Cir. 1985). Three criteria are generally said to govern motions for relief from default: whether the delay was the result of willful conduct or gross neglect;

whether the non-defaulting party will be substantially prejudiced by the delay; and whether there is a meritorious defense to the action. See, e.g., Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc., 21 U.S.P.Q.2d 1556, 1557 (T.T.A.B. 1991); Keegel v. Key West & Caribbean Trading Co., 627 F.2d 372, 373 (D.C. Cir. 1980) ("Keegel"). As shown hereinafter, Applicant satisfies each of these criteria, and is therefore deserving of relief from default and, a fortiori, from the granting of default judgment.

A. Applicant's Default Was Not The Result Of Willfulness Or Gross Negligence.

With respect to the first of the three criteria by which motions to vacate defaults are evaluated, delay arising from withdrawal of a party's counsel has been found to constitute excusable neglect and thus to have relieved the former client of a finding of willfulness or gross negligence. Brodo, supra, at 1901; Pecarsky v. Galaxiworlds.com Ltd., 249 F.3d 167, 171-73 (2nd Cir. 2001); Anilina Fabrique de Colorants v. Aakesh Chemicals, 856 F.2d 873, 877-78 (7th Cir. 1988); Bavouset v. Shaw's of San Francisco, 43 F.R.D. 296, 298 (D.C. Tex. 1967) (confusion arising from replacing counsel is a sufficient basis for relief from default judgment). In this case, Applicant's counsel, Lilenfeld, quoted a fee Applicant could not afford, and Applicant found itself without counsel. Decl., ¶¶7-8 & Exh. "B." Present counsel was not retained until well within the 30-day response period set by the Notice of Default. Id., ¶9. Under these facts, Appellant's default was neither willful nor grossly

negligent.

B. Opening The Default Will Occasion No Substantial Prejudice To Opposer.

In evaluating the second criterion for relieving a party from default, a plaintiff's delay in obtaining judgment does not constitute, in itself, undue prejudice justifying denial of relief. Keegel, supra, at 374. The kind of factors which support a finding of prejudice have been described as follows: "Delay [arising from granting relief from default] may be grounds for denying relief if it is shown that the delay will result in loss of evidence, create increased difficulties of discovery, or provide greater opportunity for fraud and collusion." 10 Moore's Federal Practice (3d ed. 2013) §55.70[2][c] at 55-89; Johnson v. Dayton Elec. Mfg. Co., 140 F.3d 781, 785 (8th Cir. 1998). There is simply no reason to suspect on this record that any of the foregoing consequences will ensue upon the granting of the requested relief to Applicant.

C. Applicant Has Meritorious Defenses.

In applying the final criterion, the existence of meritorious defenses, the test of the existence of a meritorious defense is whether a defense is presented that is legally cognizable and, if proved at trial, will constitute a complete defense to the plaintiff's claims. Keegel, supra, at ibid. In this case, Applicant's counsel ascertained that Applicant's Mark, "VAGISERT," was the subject of a previous registration (the "Previous Mark") that was issued and effective almost 35 years

before Opposer's first trademark application was filed and more than 42 years before Opposer's second trademark application was filed. Decl., ¶¶2-5 & Exh. "A." In addition, the Previous Mark remained effective for more than seven years after Opposer's first trademark was issued, and no cancellation proceedings were filed against it by Opposer. Ibid. Applicant relied on these facts in preparing and filing the Application. Id., ¶6.

These facts form the basis of several potential defenses on the part of Applicant, comprising acquiescence (see, Anheuser-Busch, Inc. v. Du Bois Brewing Co., 81 U.S.P.Q. 423, 175 F.2d 370, 374 (3d Cir. 1949) (31 years); Bunn-O-Matic Corp. v. Bunn Coffee Service Inc., 54 U.S.P.Q.2d 1012, 1021, 88 F.Supp.2d 914, 925 (consent can be implied)); laches (see e.g., SCI Systems, Inc. v. Solidstate Controls, Inc., 15 U.S.P.Q.2d 1297, 1302, 748 F.Supp. 1257, 1261 (S.D. Ohio 1990) (presumption of laches after analogous limitations period has expired)); estoppel (note that Applicant's counsel, and thus Applicant, can be said to have relied on Petitioner's actions in not seeking cancellation of the Previous Mark); and "famousness," in that the public is not likely to be misled into thinking that Applicant's Mark is a variant of Opposer's Trademarks (see, e.g., Ringling Bros. v. Utah Division of Travel, 42 U.S.P.Q.2d 1161, 1171, 955 F.Supp. 605, 619-20 (E.D.Va. 1997), aff'd, 50 U.S.P.Q.2d 1065, 1076, 160 F.3d 449 (4th Cir. 1999) (slogan "The Greatest Snow on Earth" did not dilute mark "The Greatest Show on Earth"); American Express Co. v. CFK Inc., 41 U.S.P.Q.2d 1756, 1761-63,

947 F.Supp. 310, 318-19 (E.D.Mich. 1996) (triable issue of fact whether mark "Don't Leave Home Without Me Pocket Address Book" diluted the mark "Don't Leave Home Without \_\_\_\_\_")). Each of the foregoing represents a genuine fact-based defense based upon the history of the Previous Mark and its cognizable distinctiveness from Opposer's Mark.

WHEREFORE, Applicant prays that the order to show cause why judgment by default should not be entered against Applicant in accordance with Fed.R.Civ.P. 55(b)(2) be discharged, that its default be vacated, and that Applicant be allowed such time as the Court directs to respond to the Opposition.

Respectfully submitted,

Dated: April 30, 2014

MARKE ENTERPRISES, LTD.

By: /Brian J. Jacobs/  
Brian J. Jacobs  
Brian J. Jacobs, Attorney at Law  
6464 Woodman Avenue, Suite 103  
Van Nuys, California 91401  
Telephone: (310) 770-6874  
Attorney for Appellant

DECLARATION OF MARKELA TAYLOR

I, Markela Taylor, declare as follows:

1. I am the managing member of Marke Enterprises, LLC, Applicant herein, and I am submitting this Declaration in support of Applicant's Opposition to the order to show cause why judgment by default should not be entered against Applicant in accordance with Federal Rule of Civil Procedure 55(b)(2). All of the facts set forth herein are true of my own personal knowledge and, if called upon as a witness, I could and would competently testify thereto.

2. Originally, Applicant engaged the law firm of Lilenfeld PC ("Lilenfeld") to prepare and file the trademark application for "Vagisert" ("Applicant's Mark"). In the course of preparing the application, Lilenfeld discovered that the identical trademark had previously been registered pursuant to an application filed by The Chicago Pharmacal Company, an Illinois corporation, on December 17, 1942, with a registration date of April 27, 1943 as Trademark No. 401202 (the "Previous Mark").

3. A true and correct copy of U.S. Trademark Registration No. 401202 for the VAGISERT trademark, issued April 27, 1943, together with a printout from the TSDR database showing the title and status of the VAGISERT trademark registration, are attached hereto as Exhibit "A."

4. The TSDR database printout indicates that the Previous Mark expired on January 10, 1986.

5. Exhibit 1 to the Petition herein indicates that Opposer's first trademark, no. 1104172, was filed on April 3, 1978 and was issued on October 17, 1978, and Exhibit 2 indicates that Opposer's second trademark, no. 1424503, was filed on May 13, 1998 and was issued on January 13, 1987. In other words, the Previous Mark had been issued just under 35 years before Opposer's first trademark application was filed and more than 42 years before Opposer's second trademark application was filed. In addition, the Previous Mark remained effective for more than seven years after Opposer's first trademark was issued. Finally, the TSDR database printout for the Previous Trademark shows that no cancellation proceedings were ever filed by Opposer against the Previous Mark.

6. Applicant relied on these facts in seeking registration for Applicant's Mark.

7. When the Petition was filed, the undersigned consulted with Lilenfeld concerning Applicant's defense to the Petition. The fee quoted by Lilenfeld to defend and try the proceeding initiated by the Petition was beyond Applicant's financial resources and Lilenfeld advised Applicant that it would not represent Applicant in this matter.

8. I thereupon began to seek replacement counsel, as Lilenfeld advised me that an entity, such as Applicant, can only appear in this proceeding by counsel. A true and correct copy of Sonia Lakhany's February 18, 2014 email from Lilenfeld to the undersigned confirming such firm's decision not to represent

Applicant in this matter is attached hereto as Exhibit "B."

9. Eventually Applicant was introduced to its current counsel, Brian J. Jacobs, Esq., who was retained on April 25, 2014.

I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct.

Dated: April 30, 2014

/Markela Taylor/  
Markela Taylor, Declarant

**PROOF OF SERVICE**

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES:

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action; my business address is 6464 Woodman Avenue, Suite 103, Van Nuys, California 91401.

On April 30, 2014, I served the foregoing document described as **BRIEF IN OPPOSITION TO ORDER TO SHOW CAUSE WHY JUDGMENT BY DEFAULT SHOULD NOT BE ENTERED AGAINST APPLICANT IN ACCORDANCE WITH FED.R.CIV.P. 55(b)(2)** on the interested parties in this action by placing true copies thereof enclosed in (a) sealed envelope(s) addressed as follows:

Robert R. Caliri  
Alissa A. Digman  
Olson & Cepuritis, Ltd.  
20 North Wacker Drive  
36th Floor  
Chicago, Illinois 60606

I deposited this envelope in the mail at Los Angeles, California. The envelope was mailed with postage thereon fully prepaid.

I declare under penalty of perjury under the laws of the State of California that the forgoing is true and correct.

BRIAN J. JACOBS  
Type or Print Name

/Brian J. Jacobs/  
Signature

**Registered Apr. 27, 1943**

**Trade-Mark 401,202**

Republished, under the Act of 1946, April 8, 1952, by  
Chicago Pharmacal Company, Chicago, Ill., a corporation  
of Illinois.

## **UNITED STATES PATENT OFFICE**

**The Chicago Pharmacal Company, Chicago, Ill.**

**Act of February 20, 1905**

**Application December 17, 1942, Serial No. 457,460**

# **VAGISERT**

### **STATEMENT**

*To all whom it may concern:*

Be it known that The Chicago Pharmacal Company, a corporation duly organized under the laws of the State of Illinois and located at Chicago, Illinois, and doing business at No. 5547 Ravenswood Avenue, Chicago, Illinois, has adopted and used the trade-mark shown in the accompanying drawing, for a VAGINAL SUPPOSITORY, in Class 6, Chemicals, medicines, and pharmaceutical preparations, and presents herewith five specimens or facsimiles showing the trade-mark as actually used by applicant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with the act of February 20, 1905, as amended.

The trade-mark has been continuously used and applied to said goods in applicant's business since November 4, 1942.

The trade-mark is applied or affixed to the goods, or to the packages containing the same by placing thereon a printed label on which the trade-mark is shown.

The undersigned hereby appoints Mida, Richards and Murray, a firm composed of Lee W. Mida, Brayton G. Richards and Alexander W. Murray, whose postal address is 537 S. Dearborn Street, Chicago, Illinois, its attorneys, to prosecute this application for registration, with full powers of substitution and revocation, and to make alterations and amendments therein, to receive the certificate and to transact all business in the Patent Office connected therewith.

**THE CHICAGO  
PHARMACAL COMPANY,  
By W. B. TAYLOR, Jr.,  
Secretary.**

Generated on: This page was generated by TSDR on 2014-04-25 02:43:09 EDT

Mark: VAGISERT

**VAGISERT**

US Serial Number: 71457460      Application Filing Date: Dec. 17, 1942  
US Registration Number: 401202      Registration Date: Apr. 27, 1943  
Register: Principal  
Mark Type: Trademark  
Status: This registration was not renewed and therefore has expired.  
Status Date: Jan. 10, 1986

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## Mark Information

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Mark Literal Elements: VAGISERT  
Standard Character Claim: No  
Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

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## Related Properties Information

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Publish Previously Yes  
Registered Mark:  
Previously Registered Apr. 08, 1952  
Mark Publication Date:

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## Goods and Services

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Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks "\*" identify additional (new) wording in the goods/services.

For: VAGINAL SUPPOSITORY  
International Class(es): 005      U.S Class(es): 018 - Primary Class  
Class Status: EXPIRED  
Basis: 1(a)  
First Use: Nov. 04, 1942      Use in Commerce: Nov. 04, 1942

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## Basis Information (Case Level)

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Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

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## Current Owner(s) Information

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Owner Name: CHICAGO PHARMACAL COMPANY  
Owner Address: CHICAGO, ILL.  
Legal Entity Type: ILLINOIS      State or Country Where No Place Where Organized Found  
Organized:

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## Attorney/Correspondence Information

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Attorney of Record - None  
Correspondent  
Correspondent ?  
Name/Address:  
Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Jan. 10, 1986	EXPIRED SEC. 9	

## Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted  
Affidavit of Incontestability: Section 15 - Accepted

## TM Staff and Location Information

TM Staff Information - None  
File Location  
Current Location: FILE DESTROYED  
Date in Location: Jun. 01, 1989

## Assignment Abstract Of Title Information

### Summary

Total Assignments: 1

### Assignment 1 of 1

Conveyance: CHANGE OF NAME 19640424  
Reel/Frame: 0113/0432 Pages: 4  
Date Recorded: May 20, 1964  
Supporting Documents: No Supporting Documents Available

**Assignor**  
Name: CHICAGO PHARMACAL COMPANY  
Legal Entity Type: UNKNOWN  
Execution Date: May 18, 1964  
State or Country Where Organized: No Place Where Organized Found

**Assignee**  
Name: CONAL PHARMACEUTICALS, INC.  
Legal Entity Type: UNKNOWN  
State or Country Where Organized: No Place Where Organized Found  
Address: No Assignee Address Found

**Correspondent**  
Correspondent Name: ANDERSON, LUEDEKA ET AL.  
Correspondent Address: 2157 FIELD BLDG.  
135 S. LA SALLE ST.  
CHICAGO, IL 60603

Domestic Representative - Not Found

**Subject:** Fwd: Vagisert/Vagisil  
**From:** Markela (taylormarkela@gmail.com)  
**To:** Brianjacobs21@yahoo.com;  
**Date:** Monday, April 28, 2014 11:02 PM

Kela Taylor

Begin forwarded message:

**From:** <sonia@lilenfeldpc.com>  
**Date:** February 18, 2014 at 10:09:43 AM EST  
**To:** "kela Marke" <taylormarkela@gmail.com>  
**Cc:** david@lilenfeldpc.com  
**Subject:** Re: Vagisert/Vagisil

Kela,

I tried sending these last night but the email was returned (see attached). I am attaching them again.

This email confirms that Lilenfeld PC will not be representing you in this TTAB proceeding. **Please be advised that your deadline to file an Answer is March 17, 2014. If you do not file an Answer, Vagisert will win by default. Please note the rest of the deadlines in the attached Scheduling Order.**

Sonia Lakhany  
Attorney  
Lilenfeld PC - an Intellectual Property Boutique Law Firm  
Buckhead Centre  
2970 Peachtree Road, NW  
Suite 530  
Atlanta, GA 30305  
(404) 201-2520 - telephone  
(404) 393-9710 - facsimile  
Sonia@LilenfeldPC.com

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